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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/855,714	05/16/2001	Kazuaki Ebara	31869-171865	9422

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EXAMINER

HOFFMAN, BRANDON S

ART UNIT	PAPER NUMBER
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2136

DATE MAILED: 12/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/855,714	Applicant(s) EBARA, KAZUAKI	
	Examiner Brandon Hoffman	Art Unit 2136	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 May 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☒ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file. Should applicant desire to obtain the benefit of foreign priority under 35 U.S.C. 119(a)-(d) prior to declaration of an interference, a translation of the foreign application should be submitted under 37 CFR 1.55 in reply to this action.

### ***Drawings***

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: figure 5, reference number 37. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 2, 5, 7-9, and 11-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Zoka (U.S. Patent No. 6,591,249).

Regarding claim 1, Zoka teaches a biometric authentication system comprising a first enterprise system, a second enterprise system, and a communication network interconnecting the first enterprise system and the second enterprise system (fig. 5, ref. num 24, 30, and 48), wherein:

The first enterprise system includes:

- A registration apparatus for acquiring a user's biometric information in advance of authentication, extracting features therefrom, and converting the features to template data (fig. 3),
- A first authentication apparatus for acquiring the user's biometric information during authentication, extracting features therefrom, and converting the features to authentication data (fig. 2, ref. num 16), and

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- A first database server apparatus for receiving the template data from the registration apparatus, storing and managing the template data, receiving the authentication data from the first authentication apparatus during authentication, comparing the authentication data with the template data, thereby authenticating the user (fig. 6 and 7); and

The second enterprise system includes:

- A second authentication apparatus for acquiring the user's biometric information, extracting features therefrom, and converting the features to authentication data (fig. 5 and col. 8, line 61 through col. 9, line 3), and
- A second database server apparatus for receiving the authentication data from the second authentication apparatus, requesting corresponding template data from the first database server apparatus, receiving the corresponding template data from the first database server apparatus, comparing the authentication data with the corresponding template data, thereby authenticating the user, and storing and managing the received template data if the user is authenticated successfully (fig. 8).

Regarding claim 2, Zoka teaches wherein the second database server apparatus sends the authentication data received from the second authentication apparatus to the first database server apparatus, and the first database server apparatus includes a one-to-many biometric identification unit that performs a one-to-many comparison between the authentication data received from the second database server apparatus and all of the template data stored and

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managed by the first database server apparatus to find the template data corresponding to the authentication data (col. 9, lines 3-19).

Regarding claim 5, Zoka teaches wherein:

- The first database server apparatus includes a first personal-information database storing personal information about the user (col. 5, lines 40-46);
- When the first database server apparatus sends the corresponding template data to the second database server apparatus, the first database server apparatus also sends the personal information about the user to the second database server apparatus (col. 9, lines 11-19); and
- The second database server apparatus includes a second personal-information database that stores and manages the personal information about the user received from the first database server apparatus (col. 9, lines 11-19).

Regarding claim 7, Zoka teaches a biometric authentication system comprising a first enterprise system, a second enterprise system, and a communication network interconnecting the first enterprise system and the second enterprise system (fig. 5, ref. num 24, 30, and 48), wherein:

The first enterprise system includes:

- A registration apparatus for acquiring a user's biometric information in advance of authentication, extracting features therefrom, and converting the features to template data (fig. 3),

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- A first authentication apparatus for acquiring the user's biometric information during authentication, extracting features therefrom, and converting the features to authentication data (fig. 2, ref. num 16), and
- A first database server apparatus for receiving the template data from the registration apparatus, storing and managing the template data, receiving the authentication data from the first authentication apparatus during authentication, comparing the authentication data with the template data, thereby authenticating the user, receiving authentication data from the second enterprise system, and returning corresponding template data to the second enterprise system if the corresponding template data is stored in the first database server apparatus (fig. 6 and 7 and col. 9, lines 3-19); and

The second enterprise system includes:

- A simplified registration apparatus for acquiring the user's biometric information during registration, extracting features therefrom, and converting the features to authentication data (col. 1, lines 7-16),
- A second authentication apparatus for acquiring the user's biometric information during authentication, extracting features therefrom, and converting the features to authentication data (fig. 5 and col. 8, line 61 through col. 9, line 3), and
- A second database server apparatus for receiving the authentication data from the simplified registration apparatus and the second authentication apparatus, sending the authentication data received from the simplified

registration apparatus to the first database server apparatus, receiving the corresponding template data from the first database server apparatus, storing and managing the received template data, and comparing the authentication data received from the second authentication apparatus with the stored template data, thereby authenticating the user (fig. 8).

Regarding claim 8, Zoka teaches a database server apparatus for use in a first enterprise system that is linked by a communication network to a second enterprise system (fig. 5, ref. num 24, 30, and 48), for receiving biometric template data and biometric authentication data from the first enterprise system, storing and managing the biometric template data (fig. 6 and 7), comparing the biometric authentication data with the biometric template data, thereby authenticating users of the first enterprise system, and supplying the biometric template data on request to the second enterprise system to enable users of the first enterprise system to become registered with the second enterprise system (col. 9, lines 1-19).

Regarding claim 9, Zoka teaches comprising a one-to-many biometric identification unit that performs a one-to-many comparison between biometric authentication data received from the second enterprise system and the biometric template stored and managed by the first database server apparatus to find the biometric template data requested by the second enterprise system (col. 9, lines 3-19).

Regarding claim 11, Zoka teaches comprising a personal-information database storing personal information about the users of the first enterprise system, the personal information being sent to the second enterprise system together with the biometric template data requested by the second enterprise system (col. 5, lines 40-46).

Regarding claim 12, Zoka teaches wherein the database server apparatus receives biometric authentication data from the second enterprise system, compares the received biometric authentication data with the requested biometric template data, and sends the requested biometric template data to the second enterprise system only if the received biometric authentication data match the requested biometric template data (col. 9, lines 11-19).

Regarding claim 13, Zoka teaches a database server apparatus for use in a second enterprise system that is linked by a communication network to a first enterprise system (fig. 5, ref. num 24, 30, and 48), for receiving biometric authentication data from the second enterprise system (col. 1, lines 7-16), requesting corresponding biometric template data from the first enterprise system, receiving the requested biometric template data from the first enterprise system, storing and managing the received biometric template data, and comparing the biometric authentication data with the stored biometric template data, thereby authenticating users of the second enterprise system (fig. 8 and col. 5, line 61 through col. 9, line 3).

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Regarding claim 14, Zoka teaches wherein the database server apparatus sends the biometric authentication data received from the second enterprise system to the first enterprise system when requesting the corresponding biometric template data from the first enterprise system (col. 9, lines 11-19).

Regarding claim 15, Zoka teaches comprising a personal-information database for storing personal information about the users of the second enterprise system, the personal information being received from the first enterprise system together with the requested biometric template data (col. 9, lines 11-19).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3, 4, 6, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zoka (USPN '249).

Regarding claims 3, 6, and 10, Zoka does not specifically teach wherein the first database server apparatus includes a billing unit that charges the second enterprise system a fee when the second database server apparatus requests

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corresponding template data and the first database server apparatus sends the corresponding template data and personal information to the second database server apparatus.

However, he does suggest that online merchants and banks can connect to the biometric storing entity, called "Touch Scan", and have users authorized. This is very common in systems where a website will subscribe to the services of a credit card verifying entity for a fee. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to include a billing unit that charges the online merchants and banks a fee for requesting/receiving biometric authentication for their customers. This would have been obvious because, in business, it is cheaper to have a proprietary entity supply authentication for all transactions for a nominal fee.

Regarding claim 4, Zoka as modified teaches wherein the second database server apparatus sends the authentication data received from the second authentication apparatus to the first database server apparatus when requesting the corresponding template data, and the first database server apparatus includes a one-to-many biometric identification unit that performs a one-to-many comparison between the authentication data received from the second database server apparatus and all of the template data stored and managed by the first database server apparatus to find the template data corresponding to the authentication data (col. 9, lines 3-19).

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**Conclusion**

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Uchida (U.S. Patent No. 6,751,734), Nakamura et al. (U.S. Patent No. 6,751,733), Houvener (U.S. Patent No. 6,424,249), Bianco et al. (U.S. Patent No. 6,256,737), and Kanevsky et al. (U.S. Patent No. 6,092,192)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brandon Hoffman whose telephone number is 571-272-3863. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Brandon Hoff*

BH

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PRIMARY EXAMINER  
*Art 2136*